

## REMARKS

Reconsideration is respectfully requested in view of any changes to the claims and the remarks herein. Please contact the undersigned to conduct a telephone interview in accordance with MPEP 713.01 to resolve any remaining requirements and/or issues prior to sending another Office Action. Relevant portions of MPEP 713.01 are included on the signature page of this amendment.

In regards to the five affidavits of Mitzi, Dinger, Shaw Tsuei and Duncombe the Examiner states at page 13 last paragraph:

Those affidavits do not set forth particular facts to support the conclusions that all superconductors based on the applicants' work behave in the same way and that one skilled in the art can make those superconductors without undue experimentation. Conclusory statements in an affidavit or specification do not provide the factual evidence needed for patentability.

For the reasons given in prior responses the affidavit of Duncombe provides specific factual evidence to support the conclusion that all superconductors based on applicants' work behave in the same way and that one skilled in the art can make those superconductors without undue experimentation based on applicants' teaching.

In further support of Applicants' position that their teaching fully enables their claimed invention Applicants are submitting herewith another affidavit of Thomas Shaw. The attached affidavit of Shaw clearly shows factual evidence that all superconductors based on the application of applicants' work behave in the same way and that one

skilled in the art can make those superconductors without undue experimentation. The attached affidavits of Dinger and Tsuei clearly shows that once a person of skill in the art knows of Applicants' work the other known superconductors based on applicants work can be made following applicants' teaching and the known principals of ceramic science. Moreover, from the affidavits of Dinger and Tsuei it is clear that the terms "perovskite-like", "perovskite-type", "layered-like" and "layered-type" were terms used in the ceramic arts long before applicants' priority date. Thus, there terms were well understood by persons of ordinary skill in the art long before applicants priority date.

Moreover, the term "rare earth like" or "near-rare-earth" element is understood from Applicants teaching since prior to Applicants' priority date the term rare earth included the 18 elements of atomic number 21, 39, 57, 89 and 58 to 71. Since there are only about 106 elements, the term rare-earth-like or near rare earth comes from the remaining 88 elements. At page 7 lines 8-11 of Applicants' specification states "a rare earth-like element (sometime termed rare earth element) is one whose properties make it essentially a rare earth element." Thus it is within the skill of the art to determine which of the approximately 88 elements have a property which make it essentially a rare earth element in a high T<sub>c</sub> superconductor according to Applicants' teaching.

In view of the changes to the claims and the remarks herein, the Examiner is respectfully requested to reconsider the above-identified application. If the Examiner wishes to discuss the application further, or if additional information would be required, the undersigned will cooperate fully to assist in the prosecution of this application.

Please charge any fee necessary to enter this paper and any previous paper to deposit account 09-0468.

If the above-identified Examiner's Action is a final Action, and if the above-identified application will be abandoned without further action by applicants, applicants file a Notice of Appeal to the Board of Appeals and Interferences appealing the final rejection of the claims in the above-identified Examiner's Action. Please charge deposit account 09-0468 any fee necessary to enter such Notice of Appeal.

In the event that this amendment does not result in allowance of all such claims, the undersigned attorney respectfully requests a telephone interview at the Examiner's earliest convenience.

MPEP 713.01 states in part as follows:

Where the response to a first complete action includes a request for an interview or a telephone consultation to be initiated by the examiner, ... the examiner, as soon as he or she has considered the effect of the response, should grant such request if it appears that the interview or consultation would result in expediting the case to a final action.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Dan Morris', written over a horizontal line.

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